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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,171	04/01/2004	Bernard Chaumat	CHAUMAT1	7383

1444 7590 08/12/2005

BROWDY AND NEIMARK, P.L.L.C.  
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WASHINGTON, DC 20001-5303

EXAMINER
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BROWN, JAYME L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/814,171

Applicant(s)

CHAUMAT ET AL.

Examiner

Jayme L. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/1/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9, drawn to a method for manufacturing a board for gliding over snow, classified in class 156.
  - II. Claim 10, drawn to a board for gliding over snow, classified in class 280.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as bonding the additional piece or pieces to the board after the board is molded.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Sheridan Neimark on July 11, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this

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Office action. Claim 10 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Information Disclosure Statement***

6. The information disclosure statement (IDS) submitted on 4/1/04 has been considered by the examiner.

#### ***Specification***

7. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

8. The disclosure is objected to because of the following informalities:

On page 5, line 25: "protection" should be changed to - - protective - -.

On page 6, line 37, item 2 is referred to as an outer face. On page 7, line 5, item 2 is an exterior face, and on page 7, line 32, item 2 is an upper face. It is recommended that all item 2's be changed to - -exterior face - - to keep consistent in the specification and claims.

On page 7 item 9 is referred to as an external shape (lines 15, 18, and 38) and as an exterior surface (lines 31 and 34). It is recommended that "external shape 9" be changed to - - exterior shape 9 - - to keep consistent in the specification and claims.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claim 1, the claim language is confusing since there is both open and closed claim language. There are also steps and stages that appear to also be steps.

It is recommended that claim 1 be rewritten as such:

A method for manufacturing a board (1) for gliding over snow, comprising the steps:

- a.) manufacturing a decorative and protective exterior assembly (3) having an outer surface (6) and an inner surface (7);
- b.) making at least one opening (17) in the exterior assembly (3) produced;
- c.) placing an additional piece or additional pieces on the outer surface (6) of the exterior assembly (3), each piece projects from the inner surface (7) and has at least one through-fixing zone (11) that passes through the opening or openings (17);
- d.) positioning the exterior assembly (3) with the additional piece or pieces (8) in a mold for the subsequent steps of producing the board (1) wherein the fixing zone or zones (11) of the additional piece or pieces (8) penetrate an inner structure (4) of the board (1) so as to constitute one or more securing means.

Also regarding claim 1, item 1 is referred to as a board, but in the specification, item 1 is referred to as an alpine ski. For the purposes of this office action, item 1 was considered to be a board.

Regarding claim 2, item 13 is referred to as a groove in the specification (page 8, line 12) and in claims 5-7. It is recommended that claim 2 be rewritten as such:

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The method as claimed in claim 1, wherein provision is made beforehand in the fixing zone or zones (11) for fixing the additional piece or pieces (8) for one or more grooves (13) or recesses (14, 15) in order to allow the filling of the groove or grooves (13) or the recess or recesses (14, 15) with a material for binding the inner structure (4) during the subsequent steps of producing the board (1).

Regarding claim 3, the parentheses should be removed around the phrases "if the subsequent steps of producing the board (1) comprise...".

Regarding claim 4, the term "phase" just appears to be another step. It is recommended that the claim be rewritten as such:

The method as claimed in claim 1, wherein after the step of the additional piece or pieces (8) being placed in the opening or openings (17) of the exterior assembly (3), a provision is made in the fixing zone or zones (11) for at least one brake for preventing tearing-away of the additional piece or pieces (8).

Claims 5-7 recite the limitation "the stop or stops" in line 2 of claim 5 and lines 2-3 of claims 6 and 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the structure" in line 4. There is insufficient antecedent basis for this limitation in the claim. Also item 9, which is referred to as the upper surface in the claim, is referred to as the exterior surface in the specification. It is recommended "upper surface 9" is changed to - - exterior surface 9 - - to keep consistent with the specification.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 3-4, and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colley et al. (U.S. Patent 6,309,586).

Regarding claims 1 and 9, Colley et al. teaches a method for manufacturing a board for gliding over snow (60) comprising the steps of: manufacturing a decorative and protective exterior assembly (Column 8, lines 22-26) having an outer surface and an inner surface; placing an additional piece or additional pieces (55) on the outer surface of the exterior assembly, each piece projecting from the inner surface and having at least one through-fixing zone; and positioning the exterior assembly and the additional piece or pieces (55) in a mold for the subsequent steps of producing the board wherein the fixing zone or zones of the additional piece or pieces (55) penetrate an inner structure of the board (60) so as to constitute one or more securing means. Colley et al. teaches that the molding processes could be co-injection molding, injection molding, compression molding, extrusion molding, two-step molding, etc. (Column 8, lines 7-26; Column 11, lines 5-42; Figures 5 and 7).

Colley et al. is silent toward the exterior assembly having at least one opening wherein the fixing or fixing zones of the additional piece or pieces passes through the opening or openings. One skilled in the art would have readily appreciated that if



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exterior assembly (top sheet design) were affixed onto the top surface of the board during the molding process, then openings would be formed prior to molding in order to accommodate the fixing zone or zones of the additional piece or pieces that are placed on the exterior assembly. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have openings in the exterior assembly when the exterior surface is affixed to the board in the molding process in the method of Colley et al.

Regarding claim 3, Colley et al. teaches that the material for binding the inner structure is polyurethane if the subsequent steps of producing the board comprise an injection operation. Colley et al. also teaches that any polymer material capable of being incorporated into an injection molding or co-injection molding or other molding operation (such as compression molding) can be utilized in the practice of the invention (Column 11, lines 12-56).

Regarding claim 4, Colley et al. teaches that the fixing zone or zones have a brake that prevents tearing away of the additional piece or pieces (55) (Figure 5).

Regarding claim 8, Colley et al. teaches that the additional piece or pieces will be set at least partially in the structure of the board such that the upper surface of the piece or pieces is flush with the exterior face of the board (Figures 5 and 7).

**Conclusion**

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jayme L. Brown** whose telephone number is **571-272-8386**. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Jayme L. Brown*  
Jayme L. Brown

*John T. Haran*  
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PRIMARY EXAMINER